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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,186	10/23/2003	Tomas Roztocil	H10316/JDP	8434
1333	7590	12/29/2005	EXAMINER	
BETH READ PATENT LEGAL STAFF EASTMAN KODAK COMPANY 343 STATE STREET ROCHESTER, NY 14650-2201			CHAU, MINH H	
			ART UNIT	PAPER NUMBER
			2854	
DATE MAILED: 12/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

AKC

**Office Action Summary**

Application No.

10/692,186

Applicant(s)

ROZTOCIL ET AL.

Examiner

Minh H. Chau

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10,12-20,22-30,36,37 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-20,22-26, 37 and 40-42 is/are allowed.
- 6) ☒ Claim(s) 1-7,27-30 and 36 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. The newly added independent **claims 40-42** are generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and **claims 1-10, 27-30 and 36**, directed to the **species A** (claims 1-10 and 27-30 as indicated in the Election/Restriction mailed on March 04, 2005) is no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3, 27-29 and 36** are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts et al. (US # 6,746,930).

With respect to **claims 1 and 27**, Roberts et al. teach a method and apparatus for printing monochrome pages with one color and colored pages with multiple colors comprising generating an electronic document file (col. 6, lines 46-50) having data

signals representative of sequential pages in the document, wherein the data for each page representative of whether the page is a monochrome page or a colored page (col. 6, lines 49+ and col. 9); providing a plurality of printers (110, 112) including a monochrome printer and a color printer (col. 6, lines 56-63); without creating a new document, sending the monochrome pages to a selected monochrome printer and sending the color pages to a selected color printer (see Fig. 1 and cols. 6-9 of Roberts et al.)

With respect to **claims 2 and 28**, see Fig. 1 and cols. 6-7 of Roberts et al. that teach the control station (108) examine the characteristic or contents of each page and routing pages having different characteristic to different printer for printing, thus pages with different characteristic such as monochrome pages or colored pages being format to meet the requirement of the selected printer such as black and white printer or color printer. Therefore, pages with different characteristic or monochrome pages and colored pages are not printed at the same time or printed asynchronously.

With respect to **claims 3 and 29**, see col. 7 of Roberts et al. that teach an apparatus and the method step of collating the pages having different attributes or the monochrome and the colored pages with each other into the same sequence of pages as found in the electronic document.

With respect to **claim 36**, see Fig. 1 and col. 6 of Roberts et al. that teach the printing attributes comprise at least one monochrome page and at least one colored page.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 4-7 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. as applied to claims 1-3, 27-29 and 36 above, and in view of Bhogal et al. (Pub. No. US 2003/0002069)

With respect to **claims 4 and 30**, Roberts et al. teach a method and apparatus for printing a document with pages having different printing characteristics such as monochrome pages and colored page comprising storing a list of all available printers (col. 7, lines 47-53); selecting a subset of monochrome and color printers from the list (col. 7, lines 53-55).

Roberts et al. teach all the limitation as explained above, except for the limitation of "displaying on a menu the selected subset of monochrome and color printers".

Bhogal et al. teach a method and system for selecting a printer for printing a job comprising displaying on a menu the selected subset of monochrome and color printers from the table that have a plurality of printers (see Fig. 5 and paragraphs [0040-0041] of Bhogal et al.)

In view of this teaching, it would have been obvious to one of skill in the art to modify the method and apparatus of Roberts et al. to include the method and system for

selecting a printer for printing a job comprising displaying on a menu the selected subset of monochrome and color printers as taught Bhogal et al. so that the user or operator can be easily determines the selected printers for printing.

With respect to **claims 5-7**, Roberts et al. teach a method step of sending the monochrome pages to a selected monochrome printer and sending the color pages to a selected color printer comprising using a single selection action by an operator using the mouse, accepting a selection of one of the printers from an operator marking one or more pages to be printed on the selected printer (see col. 12, lines 47-67 and col. 20, lines 52-64 of Roberts et al.)

Roberts et al. teach all the limitation as explained above, except for the limitation of *“displaying a selection menu containing entries for the selected monochrome printer and the selected color printer”*

Bhogal et al. teach a method and system for selecting a printer for printing a job comprising displaying table or a selection menu containing entries for the selected monochrome printer and the selected color printer (see Fig. 5 and paragraphs [0037-0041] of Bhogal et al.)

In view of this teaching, it would have been obvious to one of skill in the art to modify the method of Roberts et al. to include the method of selecting a printer for printing a job comprising displaying a selection menu containing entries for the selected monochrome printer and the selected color printer as taught by Bhogal et al. so that the operator can be easily recognize a list of selected printer for printing job through the displaying.

***Allowable Subject Matter***

6. **Claims 12-20, 22-26, 37 and 40-42** are allowed.
7. **Claims 8-10** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The following is a statement of reasons for the indication of allowable subject matter:

**Claims 8-10** have been indicated for containing allowable subject matter because the prior art fails to teach the entire combination of a method for printing monochrome pages with one color and colored pages with multiple colors including the steps of sending the monochrome pages to a selected printer and sending the color pages to a selected color printer further comprises accepting a selection of one of the classes of printers from the user, marking one or more pages to be printed using the class of selected printers, using a single selection action by an operator, displaying a selection menu containing entries for printers in the selected class of printers; using a single selection action by an operator, accepting a selection of one of the printers from the operator, and marking one or more pages to be printed on the selected printer.

***Response to Remarks/Arguments***

Applicant's arguments filed August 04, 2005, with respect to the previous rejection have been fully considered and are persuasive. And claims 18, 25 and 26 have been rewritten in independent form including the allowable subject matter.

Therefore, the rejection has been withdrawn and claims 12-20, 22-26, 37 and new added claims 40-42 are allowed. However, upon further consideration, new added claims 40-42 are generic to species A (claims 1-10, 27-30 and 36). Therefore, claims 1-10, 27-30 and 36 are no longer withdrawn from consideration, and a rejection have been applied to claims 1-10, 27-30 and 36 as explained in the rejection above.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H. Chau whose telephone number is (571) 272-2156. The examiner can normally be reached on M - TH 9:30AM - 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHC  
December 27, 2005

  
MINH CHAU  
PRIMARY EXAMINER